

display exclusively used by the image transfer device, for displaying an image transfer menu for effecting transfer of the image. The electronic assembly also includes a computer removably connected to the image transfer device.

Significantly, when the image transfer device is not connected to the computer, the image transfer device has a first image transfer menu available for display on the image transfer device, and when the image transfer device is connected to the computer, the image transfer device has a second type of image transfer menu available for display on the image transfer device.

Cotte et al. discloses a paper input device, for example, a scanner, that shares a serial port on a computer with another device. Upon insertion of a document into the scanner, a menu appears on a display of the computer, presenting options for processing the scanned image.

Applicants respectfully submit that Cotte et al. fails to disclose a display exclusively used by the image transfer device. In every embodiment described, the paper input device has no display of its own, but has software that utilizes a display on host computer 110. The display on host computer 110 is used for any application that may be running and is not exclusive to paper input device.

In addition, Cotte et al. fails to disclose an image transfer device having a display exclusively used by the image transfer device for displaying menus. The Office Action equates item 214 in Figure 12 of Cotte et al. to Applicants' image transfer device and states that the image transfer device includes a display 250. Applicants disagree and respectfully point out

that item 250 is a menu displayed on host computer system 110.
"The software of the input device resident on the host also generates a drop down menu 250..." (column 10, lines 42-44).

Cotte et al. also fails to disclose that the image transfer device has a first and second type of image transfer menu available for display on the image transfer device, depending on whether the image transfer device is connected to the computer. Applicants find no disclosure in Cotte et al. related to different types of menus that are dependent on a computer connection.

The Examiner correctly points out that Cotte et al. fails to disclose limitations related to whether the image transfer device is connected or not connected to the computer.

As best can be understood, the Office Action goes on to state that Cotte et al. discloses that, when the scanner is connected to the computer, a menu is displayed upon the insertion of a document to be scanned. When the scanner is inactive, a "regular menu" for the computer is displayed, and therefore it would be obvious that Cotte et al. teaches two different display menus in cases when the scanner is connected or not connected.

Applicants disagree because the menus described in the Office Action are displayed on the display of computer 110 not on an image transfer device. Cotte et al.'s scanner has no display for menus and thus has no capability to display different menus depending on whether a computer is connected or not.

More importantly, claim 1 does not merely call for having different displays, but rather first and second types of image transfer menus which are available for display. The "regular menu" displayed in Cotte et al. is not an image transfer menu of

any kind. The only image transfer menu available for display is the menu that appears in response to the sensors 222 (Figure 12) sensing a document.

Further, connecting or disconnecting the computer in Cotte et al. does not cause different menu displays. Cotte et al. discloses that drop down menu 250 and the screen shown in Figure 17 are generated in response to sensors 222 (Figure 12) sensing a document, not in response to a computer being connected or not. A person skilled in the art would not be motivated by the disclosure in Cotte et al. alone to modify the scanner in Cotte et al. such that the image transfer device has a first type of the image transfer menu available for display when the image transfer device is not connected to the computer, and has a second type of image transfer menu available when the image transfer device is connected to the computer.

At least for these reasons Applicants respectfully submit that claim 1 is patentable over Cotte et al.

Claims 1-13 depend from claim 1 and therefore are also patentable over Cotte et al.

In particular, claim 2 depends from claim 1 and recites that the image transfer device is at least one of a copier, a fax machine, or a printer. Cotte et al. fails to disclose that the image transfer device is anything but a scanner. The scanner may be connected in series with a fax modem, but in all embodiments is only a scanner. Figure 10, referred to by the Office Action, shows a host computer having a serial port," ...coupled to an input device using scanning technology (hereafter paper input device) 114 (Column 8, lines 17-19).

In figure 11A, also referred to by the Office Action, "... one embodiment of the input device paper input device 114 electronics and their connections to the host and Fax modem are shown" (column 8, lines 32-34).

At least for these reasons, Applicants respectfully submit that claim 2 includes patentable subject matter.

Claim 3 depends from claim 1 and further recites that the image transfer device includes a processor, a memory for storing the first type of the image transfer menu, and a user interface for accessing one of the types of image transfer menu displayed on the display.

Cotte et al. fails to disclose or suggest a memory for storing the first type of the image transfer menu, and also fails to disclose a user interface for accessing one of the types of image transfer menu displayed on the display. 4

While the scanner, or paper input device 114, is disclosed as having a memory 132 in Figure 11A, the memory does not store a type of image transfer menu, in particular, an image transfer menu for display on the image transfer device. All menus are generated by the host resident software, there is no disclosure related to any menus being stored in the memory of the scanner.

The scanner in Cotte et al. has no user interface for accessing an image transfer menu. The Office Action equates item 134 in Figure 11A with such a user interface. Item 134 is a UART, that is, a universal asynchronous receiver transmitter, that connects to the host computer 110. As such, Cotte et al. has no disclosure related to the UART as acting as a user interface for accessing an image transfer menu.

At least for these reasons, Applicants respectfully submit that claim 3 is patentable over Cotte et al.

Claim 4 depends from claim 3 and recites that the second type of the image transfer menu is stored in the memory of the image transfer device, the processor is programmed to display on the display the first type of the image transfer menu when the computer is not connected to the image transfer device, and that the computer has software for enabling the processor of the device to display the second type of menu on the display of the device when the computer is connected to the image transfer device.

As mentioned above, there is no disclosure in Cotte et al. related to storing menus in the memory of the scanner. Furthermore, there is no display for displaying menus on the scanner, let alone a processor programmed to display a menu on a display of the scanner. In addition, Cotte et al. fails to disclose that the computer has software enabling the processor of the scanner to display a menu on the scanner.

At least for these reasons, Applicants submit that claim 4 is patentable over Cotte et al.

Claim 5 depends from claim 3 and recites that at least a portion of the second type of the image transfer menu is stored in the computer. As defined in claim 1, the second type of image transfer menu is for display on the image transfer device. There is no disclosure in Cotte et al. of an image transfer menu for display on the scanner and no disclosure of storing such a menu on the computer.

Claim 6 depends from claim 5 and recites, inter alia, that the computer has software for sending information embodying the

portion of the second type of the image transfer menu to the processor for display of the device when the computer is connected. There is no disclosure in Cotte et al. of sending a portion of a menu from the computer to the scanner.

Claim 7 depends from claim 1 and recites that the second type of the image transfer menu includes expanded features compared to the first type. Claim 8 also depends from claim 1 and describes aspects of the first and second image transfer menus. As mentioned above Cotte et al. does not disclose or suggest a first or second menu for display on the scanner.

Claim 9 depends from claim 8 and recites, among other things, that the image transfer device is a fax machine. As mentioned above there is no disclosure in Cotte et al. that the paper input device is anything other than a scanner.

Claim 10 depends from claim 8 and describes an extra feature of the second type of menu as at least one of: a feature for collating copies, a feature for adding a logo, a feature for adding a message, a feature for adding page numbering, or a feature for adding a watermark. Applicants find no disclosure in Cotte et al. disclosing the second type of menu, and no disclosure related to collating copies, or adding a logo, a message, page numbering, or a watermark. Applicants also note that none of the citations to Cotte et al. mentioned in the Office Action disclose these features.

Claim 14 is an independent claim directed to a transfer apparatus having a reader and a controller. The transfer apparatus includes a connector for removably connecting a computer and a display connected to the controller for displaying menus comprising features for operating the transfer

apparatus. The display displays a first one of the menus when the computer is not connected to the apparatus, and the display displays a second one of the menus when the computer is connected to the apparatus, the second menu comprising extended features for operating the apparatus in comparison to the first menu.

There is no display on Cotte et al.'s scanner and no provision to display a particular menu depending on whether a computer is connected.

In the discussion of claim 1 above, the Examiner correctly points out that Cotte et al. fails to disclose limitations related to whether the image transfer device is connected or not connected to the computer. Furthermore, Applicants respectfully point out that connecting or disconnecting the computer in Cotte et al. does not cause different menu displays. Cotte et al. discloses that drop down menu 250 and the screen shown in Figure 17 are generated in response to sensors 222 sensing a document, not in response to a computer being connected or not.

In addition Cotte et al. does not display a first menu comprising features for operating the transfer apparatus when the computer is not connected. The "regular menu" displayed by Cotte et al. is not a menu for operating the transfer apparatus. Cotte et al. also fails to disclose a second menu comprising extended features for operating the apparatus in comparison to the first menu.

For these reasons, Applicants respectfully submit that claim 14 is patentable over Cotte et al.

Claims 15-18 depend from claim 14 and are also patentable over Cotte et al.

In particular, claim 15 includes features similar to claim 3, claim 16 has features similar to claim 6, claim 17 has features similar to claim 4, and claim 18 includes features similar to claims 7 and 8. The arguments supporting claims 15-18 are the same as claims 3, 6, 4, and 7 and 8, respectively.

At least for these reasons, Applicants respectfully submit that claims 15-18 are directed to patentable subject matter.

Claim 19 is directed to a method for transferring information from a first medium including providing an image transfer device having a scanner and reading an image on the first medium with the scanner.

Significantly, the method includes automatically uploading electronic data to the transfer device from a computer, automatically merging the electronic data with the image read by the scanner by a processor of the image transfer device, and transferring the merged image by the transfer device to a second medium.

A careful reading of Cotte et al. finds no disclosure related to an image device processor merging data from a computer with an image read by the scanner. In addition, there is no disclosure related to transferring such a merged image to a second medium.

At least for these reasons, Applicants respectfully submit that claim 19 is not rendered unpatentable by Cotte et al.

Claim 20 is dependent from claim 19 and, by virtue of its dependency, is patentable over Cotte et al.

Claim 21 is directed to a method for enhancing operating features of a transfer device including providing a first command menu stored in a memory of the transfer device, representing a first set of the operating features of the device, and available for display on a display of the device. The method also includes connecting a computer to the transfer device, and with the computer, enabling the device to display a second command menu when the computer is connected to the device. The second command menu represents a second set of the operating features of the device, which has expanded operating features in comparison to the first set of operating features.

Cotte et al. is not related in any way to enhancing operating features of a transfer device. Cotte et al. fails to disclose a first command menu available for display on a display of the device. There is no disclosure in Cotte et al. related to the device having a command menu stored in memory. There is also no disclosure in Cotte et al. related to a command menu representing a first set of operating features, and no disclosure related to the device having a display. Cotte et al. also fails to disclose enabling the device to disclose a second menu with the computer when the computer is connected, and fails to disclose that the second menu represents a second set of expanded features.

At least for these reasons, Cotte et al. fails to render claim 21 unpatentable.

Claims 22-26 depend from claim 21 and therefore are also patentable over Cotte et al.

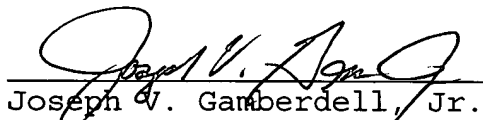
Also, claims 22-26 are method claims that recite features similar to those of claims 2-13, and therefore, for the same

reasons argued in support of claim 2-13, are patentable over Cotte et al.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

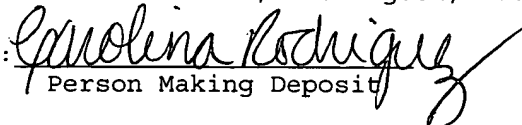
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Marked Up Claim(s)

1. (Amended) An electronic assembly comprising;

an image transfer device for reading and transferring an image from a first medium, the image transfer device including a reader for reading the image on the first medium, and a display exclusively used by the image transfer device for displaying an image transfer menu for effecting transfer of the image; and

a computer removably connected to the image transfer device;

wherein when the image transfer device is not connected to the computer the image transfer device has a first type of the image transfer menu available for display on the display of the device, and wherein when the image transfer device is connected to the computer the transfer device has a second type of the image transfer menu available for display on the display of the device.